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EXAMINER
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ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/253,153	Schwabacher
Examiner	**Art Unit**
Maurie G. Baker, Ph.D.	1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Nov 14, 2002*

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-7 and 37-46* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-7 and 37-46* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to Art Unit **1639**.

1. The Response filed November 14, 2002 (Paper No. 23) is acknowledged. Claims 1-4 were amended and no claims were added or cancelled. Therefore, claims 1-7 and 37-46 are currently pending and under examination.

Status of Rejections & Objections

2. The previous rejections under 35 U.S.C. 102 and one of the rejections under the second paragraph of 35 U.S.C. 112 are withdrawn in view of applicant's claim amendments. Also, objections to the claims and specification are withdrawn in view of applicant's amendments thereto. However, new rejections necessitated by applicant's amendments are set forth in this action. See paragraphs 19-25 for the new rejections. Note that the previous 102 rejections have been set forth as 102/103 rejections and the 103 rejection has been rewritten. Applicant's arguments are addressed following each maintained rejection. Arguments with respect to the art are addressed in paragraphs 26-32.

Maintained Rejections
Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1-7 and 37-46 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification as originally filed does not provide support for the invention as now claimed. The claims now recite that "the chemical compounds are not intermediates leading to a single final product" (claim 1) and/or various limitations based on "first [and additional] set of reagents or reaction conditions" "first [and second] specific spatial period" and "first [and additional] set of compounds" where each compound within the set "being related to all other compounds in the first [or additional] set as a product of the first set of reagents or reaction conditions". There simply does not appear to be support for the specific limitations now claimed and Applicant has not pointed to support. In accordance with MPEP § 714.02, applicants should **specifically point out support** for any amendments made to the disclosure. Also, in order for a negative limitation to be added to a claim, that particular limitation must be specifically recited in the specification.

Response to Arguments

5. Applicant's arguments filed November 14, 2002 have been fully considered but are not found persuasive. The examiner's rationale is set forth below.

6. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support ... is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). It is completely unclear that the description as filed supports the limitations described above.

7. First, as stated above, in order for a negative limitation to be added to a claim, that particular limitation must be specifically recited in the specification. Thus, the limitation of "the chemical compounds are not intermediates leading to a single final product" is

new matter as it is not set forth in the specification. Applicant argues that the instant specification supports this "idea" (Response, page 6); however, this is not deemed sufficient. Also, see MPEP 2173.05(i): Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff 'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion.

8. Second, with respect to the limitations based on "first [and additional] set of reagents or reaction conditions" "first [and second] specific spatial period" and "first [and additional] set of compounds" where each compound within the set "being related to all other compounds in the first [or additional] set as a product of the first set of reagents or reaction conditions", applicant discusses support on page 7 of the Response. The examiner does not deem this to be sufficient support. Although the portions of the specification cited by applicant in the Response do describe a process for making the claimed arrays, the language set forth in the claims doe not find sufficient support in these sections. This is especially true for the limitation that each compound within the set "being related to all other compounds in the first [or additional] set as a product of the first set of reagents or reaction conditions".

9. For these reasons, the above rejection under the first paragraph of 35 U.S.C. 112 is maintained.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 1 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 1 recites "the chemical compounds are not intermediates leading to a single final product". This is deemed to be confusing as it is unclear as to applicant's intent. Since the "intermediate", "final product" and also the reaction in question are not defined by the claim, one of ordinary skill could not determine whether or not the chemical compounds would lead to the same or different final products.

B. Withdrawn.

Response to Arguments

12. Applicant's arguments filed November 14, 2002 have been fully considered but are not found persuasive. The examiner's rationale is set forth below.

13. Applicant states that the above language would be "clear to one of ordinary skill in the art reading the claims in light of the Specification" (Response, page 7). The examiner respectfully disagrees. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, it is the

examiners position that this language is *not supported* by the instant specification (see new matter rejection above).

14. Importantly, as stated in the rejection, since the "intermediate", "final product" and also the reaction in question are not defined by the claim, one of ordinary skill could not determine whether or not the chemical compounds would lead to the same or different final products. Also note the following from MPEP 2173.02: If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. 112, second paragraph is appropriate. *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

15. For these reasons, the above rejection under the second paragraph of 35 U.S.C. 112 is maintained.

New Rejections -- Necessitated by Amendment
Claim Rejections - 35 USC § 112

16. The text of the appropriate sections of Title 35, U.S. Code are set forth above.

17. Claim 1-7 and 37-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification as originally filed does not provide support for the invention as now claimed. The claims now recite the limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array". There simply does not appear to be support for the specific limitations now claimed. Applicant has pointed to certain sections of the instant specification that describe compound repeat times but this is not deemed to be sufficient to support the added limitation, especially with respect to *each* compound being represented *at least twice* at *discontinuous regions* of the array.

18. Claim 1-7 and 37-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" is deemed to be indefinite. It is confusing because it is unclear whether the limitation is directed to arrays where multiple copies (at least two) of the compounds are present in each region, or if there are multiple regions (at least two) that contain each compound. This limitation also causes further indefiniteness as set forth in B below.

B. The claims now recite the limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array".

However, the claims are drawn to an "array of at least two different chemical compounds". It is completely unclear how an "array of at least **two** different chemical compounds" (emphasis added) could have "each chemical compound" "represented in the array at least twice at discontinuous regions of the array". Dependent claims 38, 39, 40, 42 and 43 appear to conflict with the newly added limitation of "each chemical compound is represented in the array at least twice at discontinuous regions of the array". For example, claim 42 recites that "each different compound is present at only one position on the support" and claim 43 recites that "the support has at least **two** distinct portions". This conflict adds a great deal of confusion to the claims. Thus the claims appear to have two conflicting limitations therein and this renders them indefinite.

New Rejections -- Necessitated by Amendment
Claim Rejections - 35 USC § 102/103

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 1-7, 37, 38 and 42 are rejected under 35 U.S.C. 102(b) as being as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lebl et al (EP 0 385 443 A2; on PTO-1449).

Please note the following. The meaning of the limitation that "the chemical compounds are not intermediates leading to a single final product" is unclear (see rejection under 35 U.S.C. 112, second paragraph above). The instant claims can be interpreted as follows: any chemical compound could be an intermediate for a variety of different reactions, leading to a variety of different final products. Additionally, the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" is also unclear (see rejection under 35 U.S.C. 112, second paragraph above). The limitation has been interpreted for the purposes of this rejection to

mean arrays where multiple copies (at least two) of the compounds are present in each region. Note that Lebl et al *also* discloses reaction steps cycling along the support as a function of a unique distance and time.

Lebl et al discloses a method for synthesizing oligomers on a solid support that is in the form of a band, thus forming "an array of chemical compounds" (see Abstract and Fig. 1, reference numeral 1 of the patent). The band carrier of Lebl et al is "led, e.g. by means of a series of rollers, through the appropriate reagents and washing solvents so that individual reactants are step-wise bonded" (see page 4, lines 30-34). Furthermore, in the process of Lebl the steps proceed at locally different sites (see page 4 lines 35-38). The arrays of Lebl et al are subjected to reaction conditions such as coupling of amino acids (for example) by deprotection and activation. These steps "cycle" along the support as a function of a unique distance and time (defined by the cycle through the system – see Figure 1 and page 5, lines 12-29) and clearly involve more than one reagent. See, for example, Example 10 of Lebl et al on page 9. Also, conventional protecting groups for peptide chemistry are used in the syntheses (see, for example, page 4, lines 39-46). The carriers can be those such as thread (see claims 1 and 5 of Lebl et al) which are "one-dimensional". Due to the size of the regions of the band, more than one copy of each compound would be present (see Example 2 on page 6 of the reference).

In the alternative, although the compounds in the array of Lebl et al are not specifically disclosed to be "members of a combinatorial library" as recited in

the claims as amended, the compounds of the reference are part of a collection of compounds. "Combinatorial" appears to only be a limitation on the process of making the chemical compounds. Thus the collection of compounds of the reference would read on a combinatorial library. Additionally, the examiner respectfully points out that claims 2-4 and 6 are also product-by-process claims and that any "array of chemical compounds" reads on such claims.

The array of Lebl et al meets all of the limitations of the claimed array except for the product-by-process limitations and would either anticipate or render obvious the claimed array. "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The process by which the claimed array is synthesized does not appear to lend patentable weight to the claimed invention. One of ordinary skill would expect the array to be the same regardless of the manner of synthesis.

23. Claims 1-3, 5-7, 37 and 42-46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Browne et al (Anal. Chem. 1996; of record).

Please note the following. The meaning of the limitation that "the chemical compounds are not intermediates leading to a single final product" is unclear (see rejection under 35 U.S.C. 112, second paragraph above). The instant claims can be interpreted as follows: any chemical compound could be an intermediate for a variety of different reactions, leading to a variety of different final products. Additionally, the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" is also unclear (see rejection under 35 U.S.C. 112, second paragraph above). The limitation has been interpreted for the purposes of this rejection to mean arrays where multiple copies (at least two) of the compounds are present in each region.

Browne et al disclose an "intrinsic sol-gel clad fiber optic sensor" (see Title and Abstract) which reads on the claimed "array of at least two chemical compounds attached to a support" as set forth below. The reference discloses that the "active sensor region of a fiber can be either immobilized at the distal end of an optical fiber (extrinsic) or distributed along the length of the fiber-optic waveguide (intrinsic)" (page 2289, 1st column, bottom). Specifically, Browne et al disclose a sol-gel clad optical fiber (see page 2291; Figure 1 and 1st column under 'Experimental Section; Sol-Gel Matrix'). The fiber of the reference reads on the claimed support and an array on such a fiber would inherently have "linear organization" due to the nature of the fiber.

The above-described fibers of Browne et al have sol-gel clad regions of the fiber that are created by removing the cladding from a silicone clad fiber and then replacing it with sol-gel cladding in the regions where the silicone was removed (see page 2291 1st column under 'Experimental Section; Sol-Gel Clad Fiber'). Several different dyes were used as dopants in the sol-gel regions; these dyes read on the claimed "array of at least two chemical compounds". Browne's purposely created regions of sol-gel clad fiber correspond to the claimed "regions" using different "reagents" of instant claims 2, 3 and 6. The fiber shown on page 2292 of the reference (in Figure 3 and discussed under section denoted (b)) reads specifically on the claimed array of agents as it shows a fiber that has four regions with attached AA and CV dyes that are spatially (linearly or one-dimensionally; i.e. claims 7 & 37) resolved. Due to the size of the regions of the fiber, more than one copy of each compound would be present (see page 2291 of the reference).

In the alternative, although the compounds in the array of Browne et al are not specifically disclosed to be "members of a combinatorial library" as recited in the claims as amended, the compounds of the reference are part of a collection of compounds. "Combinatorial" appears to only be a limitation on the process of making the chemical compounds. Thus the collection of compounds of the reference would read on a combinatorial library. Additionally, the examiner respectfully points out that claims 2-4 and 6 are also product-by-process claims and that any "array of chemical compounds" reads on such claims.

The array of Browne et al meets all of the limitations of the claimed array except for the product-by-process limitations and would either anticipate or render obvious the claimed array. "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The process by which the claimed array is synthesized does not appear to lend patentable weight to the claimed invention. One of ordinary skill would expect the array to be the same regardless of the manner of synthesis.

Claim Rejections - 35 USC § 103

24. The text of the appropriate sections of Title 35, U.S. Code are set forth above.

25. Claims 1-7 and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebl et al (EP 0 385 443 A2; on PTO-1449) or Browne et al (Anal. Chem. 1996; of record) in view of Lebl et al (US 5,688,696; on PTO-1449).

Note that the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" is deemed to be unclear (see rejection under 35 U.S.C. 112, second paragraph

above). The limitation has been interpreted for the purposes of this rejection to mean arrays having multiple regions (at least two) that contain each compound.

The teachings of Lebl et al (EP 0 385 443 A2) and Browne et al (Anal. Chem. 1996) are set forth supra. Please also note the interpretations of other claim limitations set forth in each rejection. The Lebl reference teaches a method for synthesizing oligomers on a solid support that is in the form of a band, thus forming "an array of chemical compounds". The Browne reference teaches an optical fiber that has four regions with attached AA and CV dyes that are spatially (linearly or one-dimensionally; i.e. claims 7 & 37) resolved.

The references lack the teaching of duplicate compounds in different positions as set forth in the instant claims 38-42 and in the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" as interpreted above.

However, it was well known in the art at the time of the invention to make duplicate arrays of compounds. For example, Lebl (US 5,688,696) teach making arrays of compounds on a similar, one-dimensional carrier (thread; see column 7, lines 30-67). Lebl (US 5,688,696) makes these arrays in duplicate (see column 8, lines 9-42) so that a control can be used in the screening of the library.

Therefore, it would have been prima facie obvious to make the one dimensional array of chemical compounds as taught by Lebl et al (EP 0 385 443 A2) or Browne et al using any number of duplicate compounds. Lebl (US 5,688,696) teach that duplicate compounds in combinatorial chemistry arrays are

advantageous in the screening process. Thus, one would have been motivated to use duplicates in the array of Lebl et al (EP 0 385 443 A2) or Browne et al as taught by Lebl (US 5,688,696) to assist in screening of the compounds of the array.

Response to Arguments

26. Although the above art rejections are new (necessitated by applicant's amendments to the claims) the arguments filed November 14, 2002 have still been fully considered. These arguments were not found persuasive. The examiner's rationale is set forth below.

27. Applicant argues that arrays of Lebl contain only intermediates and thus the limitation of "not intermediates leading to a single final product" is not met. This limitation is still deemed to be unclear for the reasons set forth above and is interpreted as follows: any chemical compound could be an intermediate for a variety of different reactions, leading to a variety of different final products. Note that the "intermediate", "final product" and also the reaction in question are ***not defined*** by the claim. Thus the compounds in the array of Lebl could be interpreted as final products.

28. See MPEP 2112.01: Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness

has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Also, "[p]roducts of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

29. Applicant also argues that both Lebl and Browne do not teach that the compounds in their arrays are "members of a combinatorial library". This has been deemed to be a process limitation which is non-limiting on the instant product claims. See rejection above.

30. Additionally, applicant argues that Browne does not teach the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array". This limitation is deemed to be unclear for the reasons set forth above and has been interpreted for the purposes of the 102/103 rejection to mean arrays where multiple copies (at least two) of the compounds are present in each region. Browne clearly teaches that due to the size of the regions of the fiber, more than one copy of each compound would be present (see page 2291 of the reference).

31. Finally, with respect to the rejection under 35 U.S.C. 103(a), even if the newly added limitation that "each chemical compound is represented in the array at least twice at discontinuous regions of the array" is interpreted to mean arrays having multiple regions (at least two) that contain each compound, the combination of Lebl (EP 0 385 443 A2) or Browne in view of Lebl (US 5,688,696) renders the claimed invention obvious. This is because Lebl (US 5,688,696) teach arrays of compounds on a similar, one-dimensional carrier and makes their arrays in duplicate so that a control can be used in the screening of the library. The interpretation of the other limitations of the claims with respect to the Lebl (EP 0 385 443 A2) and Browne references are discussed supra.

32. Other arguments directed at the methods of making and/or using the claimed arrays are not relevant to the determination of patentability of the arrays themselves. All claims currently under examination are directed to the product (array) only.

Double Patenting

33. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*,

422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

34. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35. Claims 1-7 and 37-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 6-13 and 30--50 of copending Application No. 09/535,300. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The instant claims would be obvious to one of ordinary skill in view of the claims of the co-pending application based on the fact that the instant case claims an array of compounds on a support and the co-pending case claims a similar array with the only difference being the more specifically defined support (fiber).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

36. In the Response filed November 14, 2002, applicant has asked to hold this rejection in abeyance. Thus the rejection is maintained for reasons of record.

Status of Claims/Conclusion

37. No claims are allowed.

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is

(703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
February 7, 2003

MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER